

Attorney Docket No.: ISPH-0587  
Inventors: Butler et al.  
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Group II, claims 16-25, 31-40 drawn to a method of treating or delaying a disease or condition associated with hormone sensitive-lipase in an animal, classified in class 514, subclass 44.

Group III, claims 26-30, 41-50, drawn to a method of modulating blood glucose levels in an animal, classified in class 514, subclass 44.

Group IV, claims 51-60, drawn to a method of modulating serum cholesterol levels in an animal, classified in class 514, subclass 44.

Group V, claims 61-70, drawn to a method of modulating serum triglyceride levels in an animal, classified in class 514, subclass 44.

The Examiner suggests that the Groups as set forth above are distinct each from the other because they are unrelated. It is suggested that Groups I and II-V are biologically and functionally different and distinct from each other. It is further suggested that Groups I and II and III and IV and V are methods which comprise steps which are not required for or present in the methods of the other groups.

Further, the Examiner has indicated that the antisense sequences listed in claim 3 are subject to restriction. It is

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suggested that the sequences are all unique and are targeted to and inhibit the expression of varying parts of the same gene. It is further suggested that the search of all of the sequences claimed presents an undue burden on the PTO. The Examiner has requested that the Applicants elect one sequence to be searched. Applicants respectfully traverse this requirement.

For a proper restriction requirement the MPEP §803 requires showing: (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." All of claims of the instant application relate to the single concept of modulating expression of hormone-sensitive lipase. Accordingly, each of the claims contain the components for use in the same endpoint, namely hormone-sensitive lipase inhibition. Thus, Applicants respectfully disagree that the Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01.

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Additionally, since all of the claims are related to the single concept of modulation of expression of hormone-sensitive lipase, a search relating to all of the claims in this application would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper. Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group I, claims 1-15 and 71, and SEQ ID NO: 3, with traverse. Claim 3 has been canceled. Claim 1 and claim 11 have been amended to clarify that the claimed invention is an compound targeted to a *single* disclosed species of the hormone-sensitive lipase, namely, SEQ ID NO: 3. Support for this amendment is found throughout the specification and especially at page 89. Applicants believe that these amendments satisfy the requirements of this Restriction Requirement, as only a single species of human hormone-sensitive lipase is now claimed.

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Attached hereto is a marked up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings to Show Changes Made."

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim 3 has been canceled.

Claims 1 and 11 have been amended as follows:

1. (Amended) A compound 8 to 50 nucleobases in length targeted to a nucleic acid molecule encoding human hormone-sensitive lipase (SEQ ID NO: 3), wherein said compound specifically hybridizes with and inhibits the expression of human hormone-sensitive lipase.

11. (Amended) A compound 8 to 50 nucleobases in length which specifically hybridizes with at least an 8-nucleobase portion of an active site on a nucleic acid molecule encoding human hormone-sensitive lipase (SEQ ID NO: 3).